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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,189	09/30/2004	Paul Howley	22996	7534

535 7590 01/09/2007  
THE FIRM OF KARL F ROSS  
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EXAMINER

HURT, SHARON L

ART UNIT PAPER NUMBER

1648

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/510,189	<b>Applicant(s)</b> HOWLEY ET AL.	
	<b>Examiner</b> Sharon Hurt	<b>Art Unit</b> 1648	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 20-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11 and 13-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>August 31, 2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

The amendments to the claims filed August 31, 2006 is acknowledged. Claims 1-4, 18, 20-21, 23 and 26-27 are currently amended. Claim 19 is canceled. Claims 1-18 and 20-27 are pending and under examination on the merits.

### *Response to Arguments*

#### *Rejections Withdrawn*

The rejection of claims 2-4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claims refer to “a homology at least \_\_\_% or “a homology of \_\_\_% is **withdrawn** pursuant applicant’s amendments.

The rejection of claim 19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claims does not provide steps for the method is **moot** as the claims has been canceled.

The rejection of claims 26 and 27, drawn to “the DNA sequence”, for lacking antecedent basis is **withdrawn** pursuant applicant’s amendments.

The rejection of claim 21 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is **withdrawn** pursuant to the Pielken declaration.

The rejection of claim 12 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because it was not clear if all of the deposit requirements of the recombinant poxvirus met all of the criteria has been **withdrawn**.

The rejection of claims 1-8, 10, 13-22 and 25 under 35 U.S.C. 102(b) as being anticipated by Paoletti et al. (US Patent 5,744,141) is **withdrawn**. Applicant's arguments, see pages 10-11, filed August 31, 2006, with respect to claims 1-8, 10, 13-22 and 25 have been fully considered and are persuasive.

The rejection of claims 11 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Paoletti et al. (US Patent 5,744,141) in view of Men et al. (Vaccine, 2000, Vol. 18, pages 3113-3122) is **withdrawn** pursuant applicant's arguments. Applicant's arguments, see pages 12-14, have been fully considered and are persuasive over Paoletti et al.

### **Rejections Maintained**

The rejection of claims 26-27 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is **maintained**. Applicant's arguments filed August 31, 2006 have been fully considered but they are not persuasive. Applicant argues that probes and hybridization assays are known in the art. However, applicant is arguing features, which are not claimed in the instant invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., hybridization assays using probes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

While all of the technical details of a method need not be recited, the claims should include enough information to clearly and accurately describe the invention and how it is to be practiced. The minimum requirements for method steps include a contacting step in which the reaction of the sample with the reagents necessary for the assay is recited, a detection step in which the reaction steps are quantified or visualized, and a correlation step describing how the results of the assay allow for the determination.

### *New Rejections*

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-11 and 13-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Paoletti et al. (US Patent 5,744,141) in view of Cohen et al. (US Patent 5,093,258) and further in view of Men et al. (Vaccine, 2000, Vol. 18, pages 3113-3122).

The claimed invention as described of record. The teachings of Paoletti and Men are described in the previous Office Action. Paoletti does not teach insertion of foreign genes into different sites of the viral genome.

Cohen et al. (hereinafter Cohen) teaches about insertion of DNA derived from recombinant fowlpox virus in two different sites (Column 4, lines 44-46 and Fig. 3). The host cell is infected with the fowlpox virus and then transfected with the DNA vector where virus is

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allowed to replicate and recombination occurs *in vivo* resulting in insertion of the foreign DNA (Column 3, lines 60-64).

It would have been *prima facie* obvious to the person of ordinary skill in the art at the time the invention was made to insert the foreign genes of Paoletti into different insertion sites. The person of ordinary skill in the art would have been motivated to use different sites because Cohen teaches recombination with insertion at different sites, and reasonably would have expected success because recombinant techniques have been well established in the art.

Claim 9 is free of the prior art. Claim 12 is free of the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Hurt whose telephone number is 571-272-3334. The examiner can normally be reached on M-F 8:00 - 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sharon Hurt

December 27, 2006

  
**BRENDA BRUMBACK**  
**SUPERVISORY PATENT EXAMINER**  
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